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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/802,679	03/17/2004	Kevin T. Stone	5490-000376	5339

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EXAMINER

RAMANA, ANURADHA

ART UNIT	PAPER NUMBER
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3733

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/27/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/802,679

Applicant(s)

STONE ET AL.

Examiner

Anu Ramana

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 and 23-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 and 23-39 is/are rejected.
- 7) ☒ Claim(s) 22 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 8/16/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

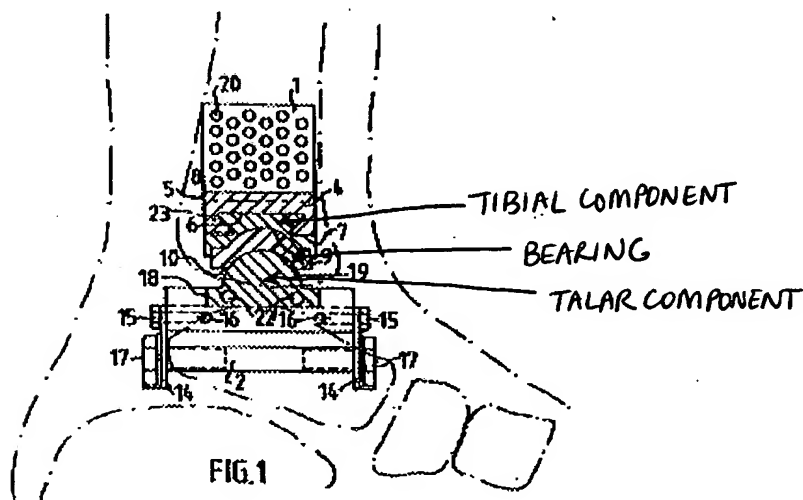
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4, 6, 13-15, 17-20, 23, 25, 26-30, 32-37 and 39 are rejected under 35 U.S.C. 102(b) as being anticipated by Persson (WO 91/07931).

Persson discloses an ankle prosthesis including: a tibial component including a dome 7; a bearing 10 with flanges wherein a convex surface articulates with a concave surface of the tibial dome 7; a talar component 12; and ribs 26 on the tibial component (Figs. 1 and 2 and pages 2-4). See marked up Fig. 1 from Persson below.



The method steps of claims 26-30 are inherently performed when the Persson ankle prosthesis is used for ankle replacement.

Claims 1-4, 6, 13-19 and 23-39 are rejected under 35 U.S.C. 102(e) as being anticipated by Deffenbaugh et al. (US 7,011,687).

Deffenbaugh et al. disclose an ankle prosthesis including: a tibial component 32 having a first dome; a bearing 36 having a second dome; and a talar component 34 wherein tibial component 32 has a pocket with slots having edges or protrusions that limit rotation of bearing 36 relative to tibial component 32 (Figs. 3-5, col. 3, lines 41-67, cols. 4-6 and col. 7, lines 1-61).

Regarding claim 16, the Deffenbaugh et al. ankle prosthesis provides flexion and extension similar to that of a normal ankle. A specific example in the prior art, which is within a claimed range, anticipates the range. MPEP 2131.03.

The method steps of claims 26-31 are inherently performed when the Deffenbaugh et al. ankle prosthesis is used for ankle replacement.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7-8 and 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deffenbaugh et al. (US 7,011,687).

Deffenbaugh et al. disclose all elements of the claimed invention except for a convex tibial dome.

It would have been an obvious matter of design choice to one skilled in the art at the time the invention was made to construct the tibial component of the Deffenbaugh et al. tibial component with convex outer surface, since applicant has not disclosed that

this solves any stated problem or is anything more than one of numerous shapes or configurations a person of ordinary skill in the art would find obvious for the purpose of providing a surface of a prosthesis contacting bone. In re Dailey and Eilers, 149 USPQ 47 (1966).

Deffenbaugh et al. teach a fin or post 58 used to secure the tibial component to the tibia. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided two fins or posts, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. St. Regis Paper Co. v. Bemis Co., 193 USPQ 8.

Claims 5, 9, 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deffenbaugh et al. (US 7,011,687) in view of Tullos et al. (US 5,658,338).

Deffenbaugh et al. disclose all elements of the claimed invention except for: (1) radial ribs on an outer surface of the tibial dome; (2) a convex tibial dome; and (2) multiple posts.

Tullos et al. teach ribs 8 arranged on an outer surface of a prosthesis to stiffen the outer surface of the prosthesis and control flow of cement used to secure the prosthesis to bone (Fig. 7, col. 6, lines 44-58 and col. 7, lines 41-59).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided ribs 8 on the outer surface of the Deffenbaugh et al. tibial component, as taught by Tullos et al., to pressurize and control the flow of cement used to secure the prosthesis to surrounding bone.

It would have been an obvious matter of design choice to one skilled in the art at the time the invention was made to construct the tibial component of the Deffenbaugh et al. tibial component with convex outer surface, since applicant has not disclosed that this solves any stated problem or is anything more than one of numerous shapes or configurations a person of ordinary skill in the art would find obvious for the purpose of providing a surface of a prosthesis contacting bone. In re Dailey and Eilers, 149 USPQ 47 (1966).

Regarding claim 21, Deffenbaugh et al. teach a fin or post 58 used to secure the tibial component to the tibia. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided two fins or posts, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Allowable Subject Matter

Claim 22 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anu Ramana whose telephone number is (571) 272-4718. The examiner can normally be reached Monday through Friday between 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached at (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3733

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AR

March 25, 2007

Anuradha Ramana